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28 AUG 2006

AUG 31 2006

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LOW SCHERER

MERCK AND CO., INC
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In re Application of: CHAKRAVARTY, Prasun, K., et al. :
U.S. Application No.: 10/553,554 :
PCT No.: PCT/US2004/011271 :
International Filing Date: 14 April 2004 :
Priority Date: 18 April 2003 :
Attorney's Docket No.: 21375YP :
For: BIARYL SUBSTITUTED THIAZOLES, :
OXAZOLES AND IMADAZOLES AS SODIUM :
CHANNEL BLOCKERS :

DECISION ON
SUBMISSION OF
DECLARATION
EXECUTED BY LEGAL
REPRESENTATIVE

Reply due
by 10/28/06

This decision is issued in response to the 18 October 2005 submission of a declaration executed on behalf of inventor Michael H. FISHER by his legal representative Jeffrey M. FISHER. No petition fee is required.

BACKGROUND

On 14 April 2004, applicants filed international application PCT/US2004.011271. The international application claimed a priority date of 18 April 2003, and it designated the United States. Payment of the U.S. basic national fee was required prior to the expiration of thirty months from the priority date, i.e., 18 October 2005.

On 18 October 2005, applicants filed a Transmittal Letter requesting entry into the national stage in the United States of America under 35 U.S.C. § 371. The Transmittal Letter was accompanied by, among other materials, payment of the basic national fee and a declaration executed by four of the five applicant/inventors and on behalf of the fifth applicant/inventor, Michael H. FISHER, by his legal representative, Jeffrey M. FISHER.

DISCUSSION

As noted above, applicants have filed a declaration executed on behalf of one of the inventor's by his legal representative. A declaration executed on behalf of an inventor by his/her legal representative may be accepted only if the application falls within the scope of 37 CFR 1.42 or 37 CFR 1.43.

37 CFR § 1.42 states:

In case of the death of the inventor, the legal representative (executor, administrator, etc.) of the deceased inventor may make the necessary oath or declaration, and apply for and obtain the patent.

37 CFR § 1.43 states:

In case an inventor is insane or otherwise legally incapacitated, the legal representative (guardian, conservator, etc.) of such inventor may make the necessary oath or declaration, and apply for and obtain the patent.

Here, applicants have not indicated which of the above provisions the declaration filed 18 October 2005 is submitted under.

Before the declaration can be accepted, applicants must provide a statement indicating that the non-signing inventor, Michael H. FISHER is either deceased (37 CFR 1.42) or "insane or otherwise legally incapacitated" (37 CFR 1.43). If neither of these regulations applies to the circumstances present here, then a declaration in compliance with 37 CFR 1.497 executed by Michael H. FISHER is required.

CONCLUSION

For the above reasons, the declaration filed 18 October 2005 on behalf of applicant/inventor Michael H. FISHER is **REJECTED** without prejudice.

Applicants have **TWO (2) MONTHS** from the mail date of the present decision to submit a proper response. Such response should include either: (1) a statement confirming that non-signing inventor Michael H. FISHER is either deceased or "insane or otherwise legally incapacitated;" or (2) an oath or declaration in compliance with 37 CFR 1.497 executed by Michael H. FISHER.

Extensions of time are available under 37 CFR 1.136(a). Failure to file a proper response will result in abandonment of the application.

Any further correspondence with respect to this matter should be addressed to Mail Stop PCT, Commissioner for Patents, P.O. Box 1450, Alexandria, Virginia 22313-1450, with the contents of the letter marked to the attention of the Office of PCT Legal Administration



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